

REMARKS

A. Status of the Application

- Claims 10 to 18 and 25 to 42 are pending in the application, of which claims 10, 25 and 34 are independent claims.

Applicants intend to pursue the subject matter of the previously cancelled claims, in one or more continuing applications.

B. Rejections Under 35 U.S.C. § 101

On page 2, the Office Action rejects claims 10 to 18 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory matter. Specifically, the Office Action claims that “a proper process must be tied to another statutory class or *transform* [sic] underlying subject matter to a different state or thing.” Applicants traverse this rejection. The Office Action fails to establish a *prima facie* case that claims are directed to non-statutory matter.

It is improper for the Office Action to reject claims 10 to 18 on the grounds that the claimed process does not result in a physical transformation, since physical transformation by a claimed process is “*not an invariable requirement, but merely one example* of how a mathematical algorithm may bring about a useful application” (emphasis added). AT & T Corp., 172 F.3d at 1357, 50 USPQ2d at 1452. See also, Diehr, 450 U.S. at 192 (the “e.g.” signal denotes that physical transformation is an example, not an exclusive requirement for satisfying § 101); Arrhythmia Research Tech., 958 F.2d at 1060, 22 USPQ2d at 1039 (Fed. Cir. 1992) (the transformation simply confirmed that Arrhythmia's method claims satisfied

§ 101 because the method produced a number which had specific meaning - a useful, concrete, tangible result - not a mathematical abstraction).

Despite transformation not being a necessary requirement, claims 10 to 18, in fact, meet the transformation threshold. Independent claim 10 recites, *inter alia*, “*routing the first order to the selected market center, in which the first order is routed according to the disclosure policy of the selected market center.*” Clearly, the act of routing an order to a selected market center necessitates the occurrence of some “*transformation*” in that order. Therefore, Applicants’ independent claim 10 (and the claims that depend therefrom) meets the transformation requirement stated in the Office Action.

Therefore, the Office Action fails to establish a *prima facie* case that the claims are directed to non-statutory matter. For at least the foregoing reasons, these claims are allowable.

C. Rejections Under 35 U.S.C. § 112

On page 3, the Office Action rejects claims 25 to 42 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particular point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Office Action claims that claims 25 to 42 represent “improper dependent claims reciting both computer readable medium and system to carry out a method of claim as stated.” The Office Action fails to establish a *prima facie* case of indefiniteness for claims 25 to 42.

Claims 25 to 42 are written as claims which reference a preceding claim—an acceptable claim construction that is proper. Claims 25 to 33 are apparatus claims which refer to a method claim. Claims 34 to 42 are article of manufacture claims which refer to a method claim. The claims have been written in simplified form for the convenience of the Examiner.

Reference to a preceding claim in order to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing. *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable, so long as it is clear that the claim is directed to the product and not the process. *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973).

For example, a product-by-process claim is a claim for a product, but contains a reference to a method claim. This type of claim is proper. A product-by-process claim is not dependent on the method claim since it does not “further limit” the method claim. Moreover, a product-by-process claim may be infringed without infringing the method claim it refers to (e.g., by selling the product). Thus, the product-by-process claim cannot be dependent on the method claim, since infringement of a dependent claim necessarily implies infringement of the base claim.

Therefore, the Office Action fails to establish a *prima facie* case of indefiniteness for claims 25 to 42. For at least the foregoing reasons, these claims are allowable.

D. Rejections Under 35 U.S.C. § 102

On page 4, the Office Action rejects claims 10 to 18 and 25 to 42 under 35 U.S.C. § 102 over U.S. Publication No. 2004/0236662 (Korhammer). However, the Office Action fails to establish a *prima facie* case of anticipation in any of the claims.

As stated by the Federal Circuit (and affirmed in MPEP § 2131), a prior art reference anticipates a patent claim only if it expressly or inherently describes “each and every limitation” set forth in the patent claim. See *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002); MPEP § 2131. Inherent anticipation requires

that the missing descriptive material is “necessarily present,” not merely probably or possibly present in the prior art. Trintec at 1295.

Each of the independent claims 10, 25 and 34 recite, *inter alia*, “***selecting, based on the disclosure policy, a market center from the plurality of identified market centers***” and “***routing the first order to the selected market center, in which the first order is routed according to the disclosure policy of the selected market center***” (emphasis added).

The cited portions of Korhammer fail to teach or disclose “***selecting, based on the disclosure policy, a market center,***” nor routing an order “***according to the disclosure policy,***” as in Applicants’ independent claims 10, 25 and 34 (emphasis added).

Korhammer discloses a system and method for routing orders for financial instruments among permissioned users. *See, e.g.*, Abstract. A permissioned user is a user with which a user of the system “can enter into user-to-user direct trades” (page 4, paragraph 36).

The cited portions of Korhammer do not discuss disclosure policies of market centers, much less, the act of selecting a market center “*based on the disclosure policy*” or routing an order to a selected market center “*according to the disclosure policy.*”

As a result, the Office Action fails to make a *prima facie* case of anticipation in any of the claims. For at least the foregoing reasons, claims 10 to 18 and 25 to 42 are allowable.

E. General Comments on Dependent Claims

Each dependent claim is patentable for at least the same reasons as the independent claim on which it depends. Thus, Applicants believe that it is unnecessary at this time to argue the allowability of each dependent claim individually. However, Applicants do not necessarily concur with the interpretation of the dependent claims as set forth in the Office

Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

F. Conclusion

In general, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as a concession of any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

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Respectfully submitted,

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